

REMARKS

Claims 44-69 are in this application, claims 70-72 having been cancelled, claims 61, 65, and 68 having been amended, and no claims having been added by this amendment.

In the Office Action, claims 44-63, and 65-67 were allowed; claims 64, 68, 69, 71, and 72 were rejected; and claim 70 was objected to.

Applicants believe that the Office Action intended the allowance of claim 64 together with claims 44-63 and the rejection of claim 65 instead, because of the substance of the rejection of claim 64, and have responded on that basis as discussed below.

No new matter is added by the amendment, as support for amended claims 61, 65, and 68 is found as follows:

Amended claim 61 replaces the term “--C(=O)OR¹⁷” with “-C(=O)OR¹⁷” to remove an extraneous hyphen.

Amended claim 65 has the names of those compounds previously referred to as “2H-benzo[3,4-d]1,3-dioxolen-5-yl” derivatives rewritten to describe them as “2H-benzo[d]1,3-dioxolan-5-yl” derivatives. While Applicants believe that the former names were definite for at least the reason that they are present in the specification in tables in which the names are correlated with chemical structures (structure Tables 1, 3, 4, and 10 and name Table 12), Applicants accept that “2H-benzo[d]1,3-dioxolan-5-yl” is standard and equally well correlatable with the structures of the specification, and have therefore made the change suggested in the Office Action.

Amended claim 68 is prior claim 68 with the list of disease states from claim 70 written in; and so is the same as former claim 70 – with one change, which is that the disease multiple sclerosis has been added to the list of disease states. Multiple sclerosis is one of the diseases listed at paragraph [0071] where a list of diseases treatable by the compounds, compositions, and methods of this invention are exemplified.

The Office Action

The rejection of claims 68, 69, 71, and 72

Claims 68, 69, 71, and 72 were rejected under 35 USC 112, ¶1 for lack of enablement, with the Office Action contending (with respect to claims 68, 69, and 71) that treating “allergic, inflammatory, and autoimmune disorders” broadly was not enabled and that the specific diseases must be recited; and (with respect to claim 72) that a person of ordinary skill in the art would not know what diseases to treat within the category of “inhibiting leukocyte migration”. The Office Action notes that claim 70, listing diseases to be treated, was objected to as being dependent on a rejected base claim but was otherwise allowable if rewritten.

Applicants have rewritten claim 68 to include the list of diseases from claim 70 – plus multiple sclerosis, as noted above – and have cancelled claims 70-72.

Since claim 68 has been amended and claim 69 depends on the amended claim 68, Applicants believe that these two claims are enabled and withdrawal of the rejection as to them is requested.

The rejection of claim 65

Claim 65 [the Office Action refers to claim 64, but this is evidently a typographical error for claim 65 when the substance of the rejection is considered] was rejected under 35 USC 112, ¶2 for indefiniteness over the naming of many of the compounds as “2H-benzo[3,4-d]1,3-dioxolen-5-yl” derivatives in the compound list of that claim.

The compounds have been renamed as suggested in the Office Action, and withdrawal of the rejection is requested.

Conclusion

Entry of the amendment and allowance of claims 44-69 are respectfully requested.

Applicants reserve the right to file divisional and/or continuation applications to the subject matter canceled in response to the previous restriction requirements in this application.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 15 July 2005

By Hugo M. Eng

FOLEY & LARDNER LLP
1530 Page Mill Road
Palo Alto, California 94304-1125
Telephone: (650) 251-1126
Facsimile: (650) 856-3710

Hugo M. Eng
Registered Patent Agent
Registration No. 50,840